III. REMARKS

The Examiner is thanked for extending the courtesy of a telephone interview on November 18, 2005. As a result the previous amendment under 37 C.F.R. 1.114 filed on 8 November 2005 is to be disregarded and this one is a substitute.

Claims 1-4, 6-12, 17, 19-22 and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 9127894.

Claims 1 and 17 have been amended to incorporate the limitations of claims 30 and 31, respectively.

The Examiner has stated that claims 30 and 31 are product-by-process claims and are therefore not untitled to patentable weight. The Examiner is directed to MPEP 2173.05(p), which states that product-by-process claims are proper, and then to MPEP 2113, which states:

> the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., In re Garnero, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.

Here the manufacturing process imports distinctive structural characteristics (surface effect of the present invention v. volume effect of JP '894)

Further, claims 1 and 17 now recite "...said surface including integrated surface formation patterns" which is not disclosed in JP '894.

For both of the above reasons, the rejections of claims 1-4, 6-12, 17 and 19-22 as anticipated by JP '894 should be withdrawn.

Claims 1-2, 8-9 17 and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa. Since Nishikawa also fails to disclose the above claimed features (it also shows volume holograms), the rejection of these claims should be withdrawn.

Also, MPEP 2144.04,IV,B "Making Intergrated" cites Schenick v. Norton Corp, 218 USPQ 698, which held that were making something integral which went against the prior art teaching by eliminating a part was patentable. Here, a volume hologram, which is slow and therefore expensive to make, is eliminated and replaced by cheap to make surface patterns on an already existing surface. Thus, both of the above sets of claims are unobvious view of JP '894 or Nishikawa.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP9127894 or by Nishikawa over Okuda. Similarly, Okuda fails to disclose the above features. Thus, combining it with either or both of the first two references does not result in the

present invention. Hence the rejection of claim 16 should be withdrawn.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi (JP9127894) or by Nishikawa (EP0821293A2) over Janson et al. (figure 30).

Similarly, since Janson fails to disclose surface formation patters, combining it with Takeuchi or Nishikawa does not result in the present invention. Thus the rejection of claim 18 should be withdrawn.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

Henry I. Steckler
Reg. No. 24,139

Nov. 18, 2005
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 11/18/05

Signature: _____
Person Making Deposit